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EXAMINER

LIU, ERIC

ART UNIT PAPER NUMBER

3628

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

10/601,983

Applicant(s)

HOLOUBEK, MICHAEL JON

Examiner

Eric Liou

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/20/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/7/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Objections

1. Claim 10 is objected to because of the following informality: grammatical error. The term "said" in line 12 should be replaced by the term "set". Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. For a claimed invention to be statutory, the claimed invention must produce a useful, tangible and concrete result. An invention which is eligible for patenting under 35 U.S.C 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a useful, concrete and tangible result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a useful tangible and concrete result. See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ 2d at 1452 and *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d at 1373, 47 USPQ 2d at 1601 (Fed. Cir. 1998). The test for practical application as applied by the examiner involves the determination of the following factors.

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a)“useful” – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will not that:

i.utility need not be expressly recited in the claims, rather it may be inferred.

ii.if the utility is not asserted in the written description, then it must be well established.

b)“tangible” – Applying *In re Warmerdam*, 33 F.3d 1354, 31 UAPQ 2d 1754 Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than manipulation of an abstract idea and is, therefore, nonstatutory under 35 U.S.C 101. In *Warmerdam*, the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

c)“concrete” – Another consideration is whether the invention produces a “concrete” result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

5. In the present case, claim 1 recites the method for processing mail items including separating mail items into an envelope batch and a contents batch, applying a first set of labels to said envelope batch, applying a second set of labels to said contents batch, scanning envelopes in said envelope batch and generating a first list of alpha-numeric characters read from said first set

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of labels and images of the envelopes in said envelope batch, scanning contents pages in said contents batch and generating a second list of alpha-numeric characters read from said second set of labels and images of the contents pages in said contents batch, and merging said envelope images with said contents pages images having common alpha-numeric characters so as to create a combined mail item image for each said mail item, but fails to provide an additional tangible step with the combined mail item image.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2, 4, 6, and 11-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 2 recites the limitations "said envelope images" and "said contents pages images" in line 17. There is insufficient antecedent basis for these limitations in the claim. The Examiner is taking "envelope images" to be the same as "images of the envelopes" (claim 1: line 9) and "contents pages images" to be the same as "images of the contents pages" (claim 1: line 11).

9. Claim 4 recites the limitations "said envelope images" and "said contents pages images" in line 6. There is insufficient antecedent basis for these limitations in the claim. The Examiner is taking "envelope images" to be the same as "images of the envelopes" (claim 1: line 9) and "contents pages images" to be the same as "images of the contents pages" (claim 1: line 11). In

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addition, the claim recites the limitation "said labels" in line 7. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 6 recites the limitation "images" in lines 16-17. There is insufficient antecedent basis for this limitation in the claim. The Examiner is taking "images" to be the same as the "said envelope images and said contents pages images" stated in claim 4, line 6.

11. Claim 11 recites the limitation "said mail article" in line 17. There is insufficient antecedent basis for this limitation in the claim. The Examiner is taking the "said mail article" to be the same as the "mail item" stated in claim 1.

12. Claim 12 recites the limitations "envelope images" and "contents pages images" (pg. 18, line 9). There is insufficient antecedent basis for these limitations in the claim. The Examiner is taking "envelope images" to be the same as "images of envelopes" (claim 12: pg. 18, line 4) and "contents pages images" to be the same as "images of contents pages" (claim 12: pg. 18, line 7).

13. Claim 15 recites the limitations "envelope images" and "contents pages images" in line 22. There is insufficient antecedent basis for these limitations in the claim. The Examiner is taking "envelope images" to be the same as "images of envelopes" (claim 12: pg. 18, line 4) and "contents pages images" to be the same as "images of contents pages" (claim 12: pg. 18, line 7).

14. Claim 16 recites the limitation "said mail article" in line 2. There is insufficient antecedent basis for this limitation in the claim. The Examiner is taking the "said mail article" to be the same as the "mail item" stated in claim 12.

Examiner's Comments

15. The prior art of record neither anticipates nor fairly and reasonably teaches a method for processing mail items, comprising, *inter alia*, the step of:

merging said envelope images with said contents pages images having common alpha-numeric characters so as to create a combined mail item image for each said mail item.

16. The most noteworthy prior art of record is to: Kruk (U.S. Patent No. 6,196,393) , Dibiaso (U.S. Patent No. 6,897,394), and van Duursen (U.S. Patent No. 5,033,725).

17. However, these references do not teach merging envelope images with contents pages images having common alpha-numeric characters read from a set of labels. The prior art teaches scanning the contents of mail and combining the contents of mail based on identical sections of text. The instant invention merges the scanned images of an envelope batch and a contents batch based on labels having common alpha-numeric characters. None of the prior art of record remedies these deficiencies.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

19. Kruk, Jr. et al., U.S. Patent No. 6,196,393, Mar. 6, 2001

20. Dibiaso et al., U.S. Patent No. 6,897,394, May 24, 2005

21. van Duursen, U.S. Patent No. 5,033,725, Jul. 23, 1991


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22. Business Editors & High Tech Writers. "NewSoft Announces Presto! PageManager 98; Gold Edition Powerful Scanning OS Tames the Paper Tiger with Fast Scanning and Accurate OCR." Business Wire. New York. May 11, 1998, pg.1
23. Klaus, Liebich, DE3124778A1, Jan. 1, 1983

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Liou whose telephone number is 571-270-1359. The examiner can normally be reached on Monday - Thursday, 7:30-5:00 and Friday 7:30-4:00 (first Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on 571-272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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